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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/231,854 01/14/99 MARTINELLI

M MRTK-001RE

EXAMINER

QM12/0129

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SHAW, S

ART UNIT

PAPER NUMBER

3737

#12

DATE MAILED:

01/29/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/231,854

Applicant(s)

Martinelli

Examiner

Shawna J. Shaw

Group Art Unit

3737



☒ Responsive to communication(s) filed on Nov 15, 2000 + 7/28/00

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-27 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☒ Claim(s) 1-22 is/are allowed.

☒ Claim(s) 23-27 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 9

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 23-25 have been considered but are moot in view of the new ground(s) of rejection.

Allowable Subject Matter

2. Claims 1-22 are allowed.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

4. Claims 23, 24 and 26 are rejected under 35 U.S.C. 102(e) as being anticipated by Bladen et al. (5,913,820) of record.

Bladen et al. disclose a position location system and method for locating a medical device having at least one sensing coil including: inducing and determining orientation and position values of the at least one coil independently of one another. See col. 2 lines 35-61, col. 3 lines 3-

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13, col. 3 lines 36-46, col. 6 lines 1-44, col. 7 line 59 - col. 8 line 31, col. 11 lines 46-53, col. 15 lines 25-28, col. 17 lines 44-47 and col. 18 lines 19-32.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 25 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bladen et al. of record in view of Ben-Haim '951 of record.

In regard to claims 25 and 27, Bladen et al. disclose a position location system and method for locating a medical device having at least one sensing coil including: independently inducing and determining orientation and position values of the at least one coil. See col. 2 lines 35-61, col. 8 lines 8-31, col. 11 lines 46-53, col. 15 lines 25-28, col. 17 lines 44-47 and col. 18 lines 19-32. Bladen et al. differ from the claimed invention in that a plurality of catheters are not specifically discussed. Ben-Haim et al. disclose a method for tracking a plurality of device and reference catheters within a patient's body. See col. 3 lines 41-59, col. 9 lines 19-42, col. 10 lines 9-43, col. 11 lines 27-51 and col. 12 lines 29-49. It would have therefore been obvious at the time the invention was made to a person of ordinary skill in the art to track more than one

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catheter as taught by Ben-Haim in the invention as taught by Bladen et al. to provide a more accurate and efficient means for performing a medical procedure.

Conclusion

7. Applicant's submission of an information disclosure statement under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p) on 7/28/00 prompted the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 609(B)(2)(I). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shawna J. Shaw whose telephone number is (703) 308-2985. The examiner can normally be reached on Monday - Friday from 8:00 a.m. to 4:30 p.m.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marvin Lateef, can be reached on (703) 308-3256. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3590.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

SJS *SS*
1/25/01



Marvin M. Lateef
Supervisory Patent Examiner
Group 3700